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09/502,377	02/11/2000	Martin Tobias	53326-019	5044

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HICKMAN PALMERO TRUONG & BECKER LLP
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EXAMINER

NGUYEN, THU HA T

ART UNIT PAPER NUMBER

2155

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/502,377

Applicant(s)

TOBIAS ET AL.

Examiner

Thu Ha T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-23 are presented for examination.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 5, 2004 has been entered.

Claim Objections

3. Claim 23 is objected to because of the following informalities: claim 23 recites the limitation "the traditional media source" in line 8. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Response to Arguments

4. Applicant's arguments filed on November 5, 2004 have been fully considered but they are not persuasive because of the following reasons:
5. Applicants argue that Willis does not teach or appear to relate to traditional media source programs. In response to Applicant's argument, Examiner asserts that Willis teaches content data at a content source 100 (figure 1, col. 8, lines 56-63) may be a number of digital forms, including data file, real-time data streams, audio, video (i.e., traditional media source programs).

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6. Applicant argues that Willis does not teach or suggest in response to receiving request, capturing the traditional media source for coding. In response to Applicant's argument, Examiner asserts that Wills does teach as shown in abstract incorporates with figure 5 and 6 that discloses in response to an initiating call (i.e., a pay per view calling) from user data (i.e., data file, data streams, audio, video...) are captured accordingly to subscriber request and the data (i.e., timing/schedule, checksum, format information) and encoded based on format information in the request by the encoder as shown in abstract, figures 1, 5, col. 8 lines 56-col. 9 lines 26, col. 10, lines 12-col. 11, lines 30.

7. Applicant argues that Willis does not teach or suggest the programs to be captured are broadcast at a particular time to a broadcasting area of the traditional media source and published to the network client located outside the broadcasting area of the traditional media source. In response to Applicant's argument, Examiner asserts that Wills does teach data are broadcast at a particular broadcast time (real-time or non real-time) scheduling to a broadcasting area. These data are stored and forward to client at a later time (which is different time at a particular time to a broadcasting area) based on scheduling service according to subscriber request and the data (i.e., format information, timing/scheduling). The network client located outside the broadcasting area of the traditional media source since these data originating broadcasted from international sources (see abstract, figures 1, 3, col. 8, lines 56-63, col. 9 lines 39-col. 10 lines 11, col.11, lines 5-42)

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8. As a result, cited prior arts do disclose a system and method for automatically recording and publishing traditional media source programs over a network, as broadly claimed by the Applicants. Applicants clearly have still failed to identify specific claim limitations that would define a clearly patentable distinction over prior art.

9. Therefore, the Examiner concludes that cited prior art teaches or suggests the subject matter broadly recited in independent claims 1, 12 and 23. Claims 2-11 and 13-22 are also rejected at least by virtue of their dependency on independent claims and by other reasons set forth in this office action [see below rejection]. Accordingly, claims 1-23 are rejected.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 5-6, 12, 16-17 and 23 are rejected under 35 U.S.C. § 102(e) as being anticipated by **Willis et al.**, (hereinafter Willis) U.S. Patent No. **6,584,082**.

12. As to claim 1, **Willis** teaches the invention substantially as claimed, including a method for automatically recording and publishing traditional media source programs over a network, the method comprising the computer-implemented steps of:

receiving from a network client that is connected to the network a request for publication of one or more traditional media source programs in one or more encoding formats (abstract, col. 3 lines 4-25, col. 8, lines 55-63 [*client/user initiates a call/sends request (i.e., a call request for pay per view movie) to gateway/server according to some protocol/format*]);

in response to receiving the request (abstract [*in response to an initiating call (i.e., a pay per view calling) from user*]), capturing the one or more traditional media source programs from a traditional media source that broadcasts the one or more traditional media source programs at a particular broadcast time to a broadcasting area of the traditional media resource (abstract, figures 1-4, col. 8 lines 56-col. 9 lines 26, col. 10, lines 12-col. 11, lines 30 [*data (i.e., data file, data streams, audio, video...) are captured accordingly to subscriber request and the data (i.e., timing/schedule, checksum, format information). These data broadcast at a particular broadcast time (real-time or non real-time) scheduling to a broadcasting area*]);

encoding the one or more traditional media source programs in the one or more encoding formats to produce one or more encoded media programs (abstract, table 3, figure 5, col. 2 lines 58-col. 3 lines 44, col. 10 lines 48-col. 11 lines 30 [*data are encoded into format using encoder*]); and

publishing, at a time different from the particular broadcast time, the one or more encoded media programs over the network to the network client located outside the broadcasting area of the traditional media resource (abstract, figures 1, 3, col. 8, lines 56-63, col. 9 lines 39-col. 10 lines 11, col.11, lines 5-42 [*data (originating from international sources, located outside from the network client, is transmitted to client/user at a later time (i.e., based on scheduling service according to subscriber request and the data (i.e., format information, timing/scheduling))*]).

13. As to claim 5, **Willis** teaches the invention substantially as claimed, wherein: the step of receiving a request for publication of one or more traditional media source programs in one or more encoding formats includes the step of receiving a request for publication of the one or more traditional media source programs in one or more streaming media formats; and the step of encoding the one or more traditional media source programs in the one or more encoding formats includes the step of encoding the one or more traditional media source programs in the one or more streaming media formats (abstract, table 3, figures 1, 3, 5, 8, col. 2 lines 58-col. 3 lines 44, col. 8 lines 54-col. 11 lines 58).

14. As to claim 6, **Willis** teaches the invention substantially as claimed, wherein: the step of receiving a request for publication of one or more traditional media source programs in one or more encoding formats includes the step of receiving a request for publication of one or more traditional media source programs in one or more

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non-streaming media formats; and the step of encoding the one or more traditional media source programs in the one or more encoding formats includes the step of encoding the one or more traditional media source programs in the one or more non-streaming media formats (abstract, table 3, figures 2-3, 8, col. 2 lines 58-col. 3 lines 44, col. 9 lines 54-col. 10 lines 11, col. 11 lines 52-58).

15. As to claim 12, **Willis** teaches the invention substantially as claimed, including a computer-readable medium carrying one or more sequences of instructions for automatically recording and publishing traditional media source programs over a network, wherein execution of the one or more sequences of instructions by one or more processors causes the one or more processors (table 3) to perform the steps of:

receiving from a network client that is connected to the network a request for publication of one or more traditional media source programs in one or more encoding formats (abstract, col. 3 lines 4-25, col. 8, lines 55-63 [*client/user initiates a call/sends request (i.e., a call request for pay per view movie) to gateway/server according to some protocol/format*]);

in response to receiving the request (abstract [*in response to an initiating call (i.e., a pay per view calling) from user*]), capturing the one or more traditional media source programs from a traditional media source that broadcasts the one or more traditional media source programs at a particular broadcast time to a broadcasting area of the traditional media source (abstract, figures 1-4, col. 8 lines 56-col. 9 lines 26, col. 10, lines 12-col. 11, lines 30 [*data (i.e., data file, data streams, audio, video...) are*

captured accordingly to subscriber request and the data (i.e., timing/schedule, checksum, format information). These data broadcast at a particular broadcast time (real-time or non real-time) scheduling to a broadcasting area]);

encoding the one or more traditional media source programs in the one or more encoding formats to produce one or more encoded media programs (abstract, table 3, figure 5, col. 2 lines 58-col. 3 lines 44, col. 10 lines 48-col. 11 lines 30 [*data are encoded into format using encoder*]); and

publishing, at a time different from the particular broadcast time, the one or more encoded media programs over the network to the network client located outside the broadcasting area of the traditional media source (abstract, figures 1, 3, col. 8, lines 56-63, col. 9 lines 39-col. 10 lines 11, col.11, lines 5-42 [*data (originating from international sources, located outside from the network client, is transmitted to client/user at a later time (i.e., based on scheduling service according to subscriber request and the data (i.e., format information, timing/scheduling))*]).

16. As to claim 23, **Willis** teaches the invention substantially as claimed, including a system for automatically recording and publishing traditional media source programs in digital format over a network, the system comprising:

a digital remote recorder (i.e., the gateway server, see abstract, figure 5), wherein the digital remote recorder is configured to receive encoding requests from a network client that is connected to the network and to automatically capture and encode the traditional media source programs, which are broadcast at a particular broadcast

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time to broadcasting area of the traditional media source, into corresponding one or more encoded media programs based on the encoding requests (abstract, figures 1-5, col. 3 lines 4-25, col. 8, lines 55-col. 9, lines 26, col. 10, lines 12-col. 11, lines 42 [Abstract incorporates with figure 6, col. 11, lines 5-42, discloses a *client/user initiates a call/sends request (i.e., a call request for pay per view movie) to gateway/server according to some protocol/format. The data (i.e., data file, data streams, audio, video...) are captured accordingly to subscriber request and the data (i.e., timing/schedule, checksum, format information) and sent to client/user*]); and a network server that is connected to the digital remote recorder, wherein the network server is configured to store the one or more encoded media programs, and to publish the one or more encoded media programs to the network client located outside the broadcasting area of the traditional media source (abstract, figures 1, 3, col. 8, lines 56-63, col. 9 lines 39-col. 10 lines 59, col.11, lines 5-42 [Abstract incorporates with figure 3 discloses *data is stored at the gateway, these data (originating from international sources, located outside from the network client, is transmitted to client/user at a later time (i.e., based on scheduling service according to subscriber request and the data (i.e., format information, timing/scheduling)*)).

17. As to claim 16-17, they are apparatus claims directed to record and publish traditional media source program over a network of method claims 5-6. Claims 16-17 have similar limitations to claims 5-6; therefore, they are rejected under the same rationale.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 2-4, 7-10, 13-15, and 18-21 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Willis** U.S. Patent No. **6,584,082**, in view of **Cragun et al.**, (hereinafter **Cragun**) U.S. Patent No. **5,973,683**.

20. As to claim 2, **Willis** does not explicitly teach the invention as claimed; however, **Cragun** teaches the step of causing a viewer interface to be displayed at the network client, wherein the viewer interface: allows selection of the one or more traditional media source programs for encoding; and allows specification of publishing parameters; wherein the step of publishing is performed based on said publishing parameters (abstract, figures 2, 3, 5, col. 5 lines 55-col. 6 lines 28, col. 7 lines 40-col. 10 lines 49). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of **Willis and Cragun** to cause a viewer interface to be displayed at the network client, wherein the viewer interface:

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allows selection of the one or more traditional media source programs for encoding; and allows specification of publishing parameters; wherein the step of publishing is performed based on said publishing parameters because it would have an efficient communication system for utilizing, controlling and selecting the content source displayed on a viewer interface which help to reduce undesirable viewing time.

21. As to claim 3, **Willis** does not explicitly teach the invention as claimed; however, **Cragun** teaches wherein the selection of the one or more traditional media source programs for encoding includes selecting traditional media source programs a broadcast of which, from the traditional media source, is not generally receivable at the geographic location at which the network client resides (figure 2, col. 10 lines 22-36). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of **Willis and Cragun** to have the selection of the one or more traditional media source programs for encoding includes selecting traditional media source programs a broadcast of which, from the traditional media source, is not generally receivable at the geographic location at which the network client resides because it would have an efficient system that can allow viewer selects and views variety of kind of content sources in different geographic locations.

22. As to claim 4, **Willis** does not explicitly teach the invention as claimed; however, **Cragun** teaches wherein the specification of publishing parameters includes specifying a time of publication of each of the one or more encoded media programs to

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the network client (figures 2, 3, col. 10 lines 22-60). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of **Willis and Cragun** to have the same motivation as set forth in claim 2.

23. As to claim 7, **Willis** does not explicitly teach the invention as claimed; however, **Cragun** teaches the step of notifying the network client that the one or more traditional media source programs have been encoded in the one or more encoding formats to produce one or more encoded media programs (figure 2, col. 7 lines 50-col. 9 lines 65). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of **Willis and Cragun** to have the step of notifying the network client that the traditional media source programs have been encoded in the encoding format because it would have an efficient communication system that can control, track and select sources when the sources are available to help reduce undesirable viewing time.

24. As to claim 8, **Willis** does not explicitly teach the invention as claimed; however, **Cragun** teaches the step of notifying the network client includes the step of notifying the network client via an e-mail message (figure 2, col. 9 lines 47-col. 10 lines 7). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of **Willis and Cragun** to have the same motivation as set forth in claim 7, supra.

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25. As to claim 9, **Willis** does not explicitly teach the invention as claimed; however, **Cragun** teaches the step of sending an e-mail message to the network client, wherein the e-mail message includes a link which when selected initiates the transmission of one of the one or more encoded media programs to the network client (figure 2, col. 9 lines 7-col. 10 lines 60). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of **Willis and Cragun** to have the same motivation as set forth in claim 7, supra.

26. As to claim 10, **Willis** does not explicitly teach the invention as claimed; however, **Cragun** teaches the step of sending an e-mail message to the network client, wherein the e-mail message includes a link which when selected causes a Web page to be displayed at the network client that includes controls that allow a user of the network client to initiate the transmission of one of the one or more encoded media programs to the network client (figures 2, 3, col. 9 lines 7-col. 11 lines 67). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of **Willis and Cragun** to have the same motivation as set forth in claim 7, supra.

27. As to claims 13-15 and 18-21, they are apparatus claims directed to record and publish traditional media source program over a network of method claims 2-4, and 7-10. Claims 13-15, and 18-21 have similar limitations to claims 2-4, and 7-10; therefore, they are rejected under the same rationale.

28. Claims 11 and 22 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Willis** U.S. Patent No. **6,584,082**, and **Cragun** U.S. Patent No. **5,973,683**, further in view of **Day et al.**, (hereinafter Day) U.S. Patent No. **5,941,951**.

29. As to claim 11, **Willis and Cragun** do not explicitly teach the invention as claimed; however, **Day** teaches the step of adding a link to a Web page that is associated with the network client, wherein the link allows a user of the network client to initiate the transmission of one of the one or more encoded media programs to the network client (figure 1, col. 4 lines 1-51). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of **Willis, Cragun and Day** to have the adding a link to a Web page step because it would have an efficient system that can add and access to variety of links in a web page.

30. As to claim 22, it is an apparatus claim directed to record and publish traditional media source program over a network of method claim 11. Claim 22 has similar limitations to claim 11; therefore, claim 22 is rejected under the same rationale.

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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Moskowits et al. (US. Pat. No. 5,629,732) discloses a multimedia server retrieves, stores and serves a subscriber requesting a movie event based on subscriber requesting format.

Guedalia (US. Pub. No. 2003/0135867) discloses a system for transmitting digital data over a bandwidth link by compressing/encoding digital data using encoder.

Graham (US. Pat. No. 6,732,183) discloses using a proxy module for streaming video and audio data from a network server to plurality of clients.

Mao et al. (US. Pat. No. 6,459,427) discloses a system and method for mapping/formatting and transmitting data through a digital TV network to receivers.

McCoy et al. (US. Pat. No. 6,526,575) discloses system and method for distributing, broadcasting and customizing multimedia by each downlink facility in order to better inform and entertain viewers.

Fuller (US. Pat. No. 5,818,512) discloses a system and method for enabling store, forward and decode of digitalized video programs.

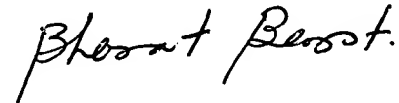
32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Ha Nguyen, whose telephone number is (571) 272-3989. The examiner can normally be reached Monday through Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SPE Hosain T. Alam, can be reached at (571) 272-3978.

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Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications.

A handwritten signature in black ink, reading "Bharat Barot". The signature is written in a cursive, flowing style.

BHARAT BAROT
PRIMARY EXAMINER

Thu Ha Nguyen

January 19, 2005